

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 6/19/2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

2. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6-11, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,699,528 to Hogan (Hogan) in view of US Patent 4321,672 to Braun (Braun).

With respect to claim 1

Hogan teaches:

A method of processing a debt payment on a consumer debt obligation using a network comprising the steps of:

communicating consumer debt obligation information for at least one consumer debt obligation from at least one debt servicer responsible for said at least one consumer debt obligation (i.e. payees) to a third party payment facilitator (i.e. electronic bill servicing company) when a consumer (i.e. subscriber) has indicated to the at least one debt servicer that the consumer elects to use the third party payment facilitator to effect future payments over a network (see col 4, lines 45 - col 5, line 43);

storing said consumer debt obligation information in a computer database separate from said at least one debt servicer (i.e. billing data transmitted to server computer, see col 5, lines 1-2, note that the server computer is associated with the electronic bill servicing company and not the payee);

receiving command information with a network access device from the consumer sufficient to identify the consumer debt obligation (i.e. elicit necessary information from the subscriber, see col 5, lines 22-24);

accessing said consumer debt obligation information to retrieve at least a portion of said consumer debt obligation information corresponding to said Command information (i.e. browse bills, see col 5, lines 1-6); and

transmitting said portion of said consumer debt obligation information to a transaction processor associated with the network to facilitate a transaction requesting that funds be transferred from an account associated with said consumer to at least one account at a banking institution associated with said at least one debt servicer whereby a payment on the consumer debt obligation is made (see col 8, lines 33-44).

Hogan does not explicitly teach an ATM network or ATM network access device. However, Braun teaches the use of an ATM network and ATM Network access devices to process payments (see col 15, lines 14-16).

It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have substituted the private network taught by Hogan (see col 2 line 24) with the ATM network taught by Braun (see col 5 17-21). It would have been further obvious to substitute the personal computer

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taught by Hogan (see col 3, lines 49-50) with the ATM terminal taught by Braun (see col 5, lines 7-10) in order to complete financial transactions without the manual handling of paper as explicitly taught by Braun (see col 2, lines 44-46).

With respect to claim 2

Hogan as modified by Braun teaches:

The method of claim 1 (see rejection of claim 1 above) wherein said at least one banking institution comprises a first banking institution and a second banking institution, and wherein a first portion of said funds is transferred to an account at said first banking institution and a second portion of said funds is transferred to an account at said second banking institution (see Hogan col 8, lines 33-44, note that multiple payees receive payments). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 3

Hogan as modified by Braun teaches:

The method of claim 1 (see rejection of claim 1 above) further comprising the step of converting said consumer debt obligation information communicated in a first data format from said at least one debt servicer into a second data format (see Hogan col 4, lines 53-67, note that the capture device extracts billing data (second data format) from bill images (first data format)). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 4

Hogan as modified by Braun teaches:

The method of claim 3 (see rejection of claim 3 above) wherein said first data format is incompatible with the ATM network and said second data format is compatible with said ATM network (see Hogan col 4, par 53-67, note that in the case where the billing data is a magnetic tape (first data format), this data must be converted from the magnetic tape format, since a reel magnetic tape is not a format capable of being transmitted over an ATM network). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 6

Hogan as modified by Braun teaches:

The method of claim 1 (see rejection of claim 1 above) further comprising the step of verifying that sufficient funds are present in said account associated with said consumer to satisfy said consumer debt obligation (see Hogan col 8, lines 44-50). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 7

Hogan as modified by Braun teaches:

The method of claim 1 (see rejection of claim 1 above) further comprising the steps of receiving a confirmation record from said transaction processor, said confirmation record indicating that said funds have been

transferred, and modifying said computer database in response to said confirmation record (i.e. authorization of valid payments, see Hogan col 8, lines 44-46). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 8

Hogan as modified by Braun teaches:

The method of claim 7 (see rejection of claim 7 above) further comprising the step of transmitting a confirmation record to said at least one debt servicer institution through a communications path separate from said ATM network (see Hogan col 7, lines 21-24, note that an email message would be transmitted via the Internet or other public network and not the private ATM network). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 9

Hogan as modified by Braun teaches:

A method for providing information concerning a consumer debt obligation to a consumer of an ATM network comprising the steps of:

communicating consumer debt obligation information for at least one consumer debt obligation from at least one debt servicer responsible for said at least one consumer debt obligation to a third party payment facilitator when a consumer has indicated to the at

least one debt servicer that the consumer elects to use the third party payment facilitator (see Hogan col 4, lines 45 - col 5, line 43);

storing said consumer debt obligation information in a computer database separate from said at least one debt servicer (i.e. billing data transmitted to server computer, see Hogan col 5, lines 1-2, note that the server computer is associated with the electronic bill servicing company and not the payee);

receiving commands with an ATM network access device from the consumer identifying the consumer debt obligation and the information about said consumer debt obligation desired by the consumer (i.e. elicit necessary information from the subscriber, see Hogan col 5, lines 22-24);

accessing said computer database in response to said commands to retrieve at least a portion of said consumer debt obligation information from said database; transmitting said portion of said consumer debt obligation information through said ATM network to said ATM network access device (i.e. browse bills, see Hogan col 5, lines 1-6); and

providing, through said ATM network access device, said portion of said consumer debt obligation information to the user (i.e. browse bills, see Hogan col 5, lines 1-6). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 10

Hogan as modified by Braun teaches:

A system for processing a debt payment on a consumer debt obligation using an ATM network comprising:

debt servicer access means for communicating consumer debt obligation information for at least one consumer debt obligation from at least one debt servicer responsible for said at least one consumer debt obligation to a third party payment facilitator when a consumer has indicated to the at least one debt servicer that the consumer elects to use the third party payment facilitator (see Hogan col 4, lines 53-67);

storage means connected with said debt servicer access means for storing said consumer debt obligation information in a computer database separate from said at least one debt servicer (i.e. server computer, see Hogan col 5, lines 1-2, note that the server computer is associated with the electronic bill servicing company and not the payee);

ATM network access means connected with said storage means for transferring at least a portion of said consumer debt obligation information to an ATM network (see Hogan col 4, lines 53-67). (see rationale for obviousness and motivation to combine of claim 1)



With respect to claim 11

Hogan as modified by Braun teaches:

The system of claim 10 (see rejection of claim 10 above) further comprising conversion means connected between said debt servicer access means and said storage means for conveying said consumer debt obligation information communicated from said at least one debt servicer from a first format compatible with said at least one debt servicer to a second format compatible with said ATM network (i.e. bill capture device, see Hogan col 4, lines 53-67). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 13

Hogan as modified by Braun teaches:

The system of claim 10 (see rejection of claim 10 above) wherein said at least one debt servicer comprises a first debt servicer and a second debt servicer, and wherein said consumer debt obligation information communicated from said first debt servicer is in a first format and said consumer debt obligation information communicated from said second debt servicer is in a second format different from said first format (see Hogan col 4, lines 53-67, note that the capture device extracts billing data (second data format) from bill images (first data format)). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 14

Hogan as modified by Braun teaches:

The system of claim 10 (see rejection of claim 10 above) further comprising:

input means for receiving commands using an ATM network access device from a user identifying the consumer debt obligation and the consumer debt obligation information desired by the user (i.e. ATM terminal, see Braun col 5, lines 7-10);

database accessing means connected with said input means and said ATM network access means for accessing said computer database in response to said commands to retrieve at least a portion of said consumer debt obligation information from said database (i.e. server computer, see Hogan, col 5, lines 1-3);

transmission means connected with said database accessing means for transmitting said portion of said consumer debt obligation information through said ATM network to said ATM network access device (i.e. interface between server computer and network, see Hogan, col 5, lines 1-3 note that it is implicit that the server computer have an interface so that bill data may be transmitted to it); and

information providing means connected with said transmission means for providing, through said ATM network access device, said portion of said consumer debt obligation

information to the user (i.e. ATM terminal, see Braun col 5, lines 7-10). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 15

Hogan as modified by Brown teaches:

The system of claim 10 (see rejection of claim 10 above) further comprising:

input means for receiving commands using an ATM network access device from a user identifying the consumer debt obligation (i.e. ATM terminal, see Braun col 5, lines 7-10);

database accessing means connected with said input means and said ATM network access means for accessing said computer database in response to said commands to retrieve at least a portion of said consumer debt obligation information from said database (i.e. server computer, see Hogan, col 5, lines 1-3);

transmission means connected with said database accessing means for transmitting said portion of said consumer debt obligation information to a transaction processor associated with the ATM network to facilitate a transaction requesting that funds be transferred from an account associated with said consumer to an account at a banking institution associated with said at least one debt servicer (i.e. interface between server

computer and network, see Hogan, col 5, lines 1-3 note that it is implicit that the server computer have an interface so that bill data may be transmitted to it). (see rationale for obviousness and motivation to combine of claim 1)

With respect to claim 16

Hogan as modified by Braun teaches:

A method of providing a reminder of a payment due on a debt obligation to a consumer using an ATM terminal during an ATM transaction session comprising the steps of:

communicating consumer debt obligation information from at least one debt servicer responsible for said debt obligation to a third party payment facilitator when the consumer has indicated to the at least one debt servicer that the consumer elects to use the third party payment facilitator (see Hogan col 4, lines 45 - col 5, line 43);

accessing through an ATM network, in response to initiation of the ATM transaction session by the consumer, a database including the consumer debt obligation information said consumer debt obligation information including at least a payment due date, said database being associated with the third party payment facilitator (i.e. browse bills, see Hogan col 5, lines 1-6);

retrieving from said database, said payment due date for said consumer debt obligation; and displaying on the ATM terminal

an indication that a payment is due in response to said payment due date for said consumer debt obligation (see col 6, lines 9-31, note that the bill having the earliest due date is displayed first). (see rationale for obviousness and motivation to combine of claim 1)

6. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as modified by Braun, and further in view of *ANSI Releases EDI Standards for Billing*, Health Management Technologies, Oct 1996, pg 10. (ANSI).

With respect to claim 5

Hogan as Modified by Braun teaches:

The method of claim 3 (see rejection of claim 3 above), but does not explicitly teach wherein said second data format complies with one of the ANSI X.9, ANSI X.12, and ISO 8583 standards.

ANSI teaches:

wherein said second data format complies with one of the ANSI X.9, ANSI X.12, and ISO 8583 standards (see pg 10).

It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have provided the system and method taught by Hogan as modified by Braun with the data format taught by ANSI in order to make billing and payment cycle readily available to service providers and consumers as taught explicitly by ANSI (see pg 10).

With respect to claim 12

Hogan as modified by Braun and ANSI teaches:

The system of claim 11 (see rejection of claim 11 above) wherein said second format complies with one of the ANSI X.9, ANSI X.12, and ISO 8583 standards (see ANSI, pg 10). (see rationale for obviousness and motivation to combine of claim 11)

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,304,860 ('860) in view of Hogan as modified by Braun.

With respect to claims 1, 9, and 14-16

The present application recites claims that are broader than and encompassing those of '860.

With respect to claims 2-8, 10, and 11

Hogan as modified by Braun and ANSI teaches the obviousness of these claims as detailed in the rejections above.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Bomberg can be reached on (571) 272-4922. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

-bf

/Mary Cheung/  
Primary Examiner, Art Unit 3694